

REMARKS

Claims 1-24 and 27 are pending in the application.

Claims 1-24 and 27 have been rejected.

Claim 1 has been amended solely to correct an informality. Reconsideration of the Claims is respectfully requested.

I. **REJECTIONS UNDER 35 U.S.C. § 103**

Claims 1-9 and 15-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helfrich (US 6,097,941) in view of Helfrich (US 6,636,733) in further view of Akahane (US 5,881,104).

Claims 10-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helfrich (US 6,097,941) in view of Helfrich (US 6,636,733) in view of Akahane (US 5,881,104) and further in view of Luzeski (US 6,301,245).

Claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Baxter (US 6,385,306) in view of Helfrich (US 6,636,733).

The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re*

Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Applicant respectfully submits that Helfrich '941 fails to disclose, teach or suggest "a voice message file in a compressed file format" such that the "received voice message comprises a

compressed audio portion and an information portion” and the “compressed audio portion is generated by conversion from a first file format to the compressed file format”. See, Claims 1, 23 and 24. The Office Action further argues that (1) Helfrich ‘733 discloses a mobile phone that receives an email message that includes an attached file containing a voice message, and (2) Akahane discloses a voice message exchange system wherein the transmitting and receiving mobile phones include voice data compression and decompression of the voice data, and therefore, Applicant’s claimed invention is obvious. See, Office Action, page 3.

Applicant respectfully submits that the Office Action mischaracterizes the disclosure of Helfrich ‘733. The Office Action argues that Helfrich ‘733 recites a mobile phone that receives an email message with an attached voice message. This is not shown or disclosed. Instead, Helfrich ‘733 discloses that an email server receives an email message (with an attached voice message) from a third party, and that only all or a portion of the text portion (of the email message) is received by the mobile phone – not the voice message that was attached to the email message received by the email server. To hear (listen) to the voice message, the mobile phone user “places a call to the message center 18” and the message is “played” to the mobile phone user over the telephone connection. See, Col. 7, lines 1-27. Thus, Helfrich’s does not download a voice message file to the mobile phone, but instead “plays” the voice message to the mobile phone so the user can “hear” the voice message. Applicant’s claims recite that the voice message file is compressed and the compressed file is downloaded to the handheld device. Therefore, Applicant’s claimed invention is distinctly different from the disclosure of the Helfrich ‘773 reference.

The Akahane reference, on the other hand, is mainly directed to real-time conversion at a portable terminal of analog audio to digital data that is stored, then “compression” of the stored digital data by deletion of a portion of the stored digital data, and transmission of the remaining digital data. Col. 4, line 45 thru Col. 5, line 19. As such, it does not appear that Akahane discloses, teaches or suggests a voice message stored in a first file format that is compressed into a compressed file format (i.e., a different file format), but only that a portion of the digital data is merely deleted and sent – not different file formats. Therefore, Applicant respectfully submits that the proposed combination of Helfrich-Helfrich-Akahane fails to disclose, teach or suggest all of the recited features as arranged as they are in Applicant’s claims

With respect to the rejection of Claims 10-14, for the reasons set forth above with respect to the 103 rejection based upon Helfrich ‘941, Helfrich ‘733 and Akahane, these claims include elements/feature not disclosed, taught or suggested by these three references, and further, that Luzeski fails to cure the noted deficiencies of those references.

With respect to the rejection of Claim 27, Baxter recites:

... The voice message is compressed and encoded into a digital audio file 40 and then attached to the email address previously identified 110. The email and digital audio file attachment is then opened and listened to by the recipient 260. ... Col. 10, lines 19-23.

This passage (and Figure 6) describes that the voice message (audio) is compressed and sent via email (to the email address previously input or designated by the user generating the voice message) as an email attachment. Baxter appears to compress the recorded voice message into a digital audio file which is then sent via email to an email address. No information portion,

other than the compressed audio portion, is included in Baxter's compressed digital audio file. The email address provides a destination address for the email (with attached file) and the email address is not provisioned in the second file format (i.e., the compressed audio file format). Baxter fails to disclose that the compressed message file (in the second file format) includes both a compressed audio portion and an information portion where the information portion is stored in one or more text fields provided for in the second file format. Applicant notes that it has provided an accurate description (above) of the subject matter actually disclosed by Helfrich '733. To summarize, Helfrich '733 is directed to email messages, and no voice message file appears to be downloaded to the handheld device. Moreover, Helfrich '733 fails to recite an information portion where the information portion is stored in one or more text fields provided for in the second file format. As such, none of the cited references either alone or in combination disclose, teach or suggest each and every feature as recited in Applicant's Claim 27.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 1-24 and 27.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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